

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendment and following remarks.

Thus, claim 1 has been amended to recite that the polymerization is conducted at a temperature of 20 to 60°C. The disclosure at page 20, line 2 of the specification sets forth a range of 20 to 150°C; and all of Examples 1-9 and 11-30 recite a polymerization temperature of 60°C. Applicants thus respectfully submit that the polymerization temperature range of 20 to 60°C in amended claim 1 is supported by the specification.

The patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-3 under 35 U.S.C. §103(a) as being obvious over Yamago et al. in view of Alger is respectfully traversed.

The present invention uses an organotellurium compound represented by the formula (1), an azo type polymerization initiator, and a ditelluride compound represented by the formula (2) in the polymerization reaction, and achieves the excellent effects that a polymer can be obtained under **more mild conditions** and in a high yield (see page 2, lines 14-22, and the working examples in the specification).

Yamago et al. show reactions conducted at 80 to 105 °C as indicated on page 13666, Table 1 middle column (conditions).

There is no suggestion in the Yamago et al. reference which would lead one of ordinary skill in the art to expect that the reaction disclosed in this reference could be conducted at a temperature within the range of 20 to 60°C as set forth in the presently claimed invention.

The Alger reference gives a definition for azo initiator, i.e. merely teaches that an azo initiator is a well known type of initiator for polymerization. It is commonly known that polymers prepared with use of azo initiator inherently have broad molecular weight distributions or polydispersities. For example, in Polymer Bulletin 43, 143-150 (1999), a copy of which is of record, cited on page 2 of the present specification, styrene is polymerized with use of AIBN only to obtain polystyrene having PD(Mw/Mn)=**2.46** in Table 2, run 1 of page 146.

Accordingly, a person skilled in the art would not combine the azo initiator with the method disclosed in Yamago et al., since the azo initiators inherently have broad molecular weight distributions or polydispersities.

After acknowledging that the Yamago et al. reference does not disclose the use of an azo type polymerization initiator, and noting that such type of initiators are disclosed in Alger, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to incorporate azo type polymerization initiators as taught by Alger in Yamago et al.'s polymerization process with reasonable expectation of success, because it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, citing *In re Kerkhoven*, *In re Crockett* and *Ex parte Quadranti*.

However, referring to MPEP 2143 and 2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; and obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so, citing *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006); and further, the teaching, suggestion or motivation must be found either explicitly or implicitly **in the references themselves or in the knowledge generally available to one of ordinary skill in the art**. Please note that the *In re Kahn* decision was handed down well after the CCPA decisions (*In re Kerkhoven* and *In re Crockett*) cited by the Examiner, and that unlike the *Ex parte Quadranti* decision cited by the Examiner, which is a Board of Patent Appeals and Interferences decision, the *In re Kahn* decision was handed down by the CAFC, which takes precedence over Board decisions.

Applicants take the position that the Examiner has failed to establish that there is any teaching, suggestion, or motivation to combine the Yamago et al. and Alger references, and therefore, has failed to establish a *prima facie* case of obviousness. The Alger reference is merely a dictionary, which defines "azo initiator", and as noted by the Examiner, Yamago et al. does not disclose use of azo type initiators. The references certainly do not provide the art-skilled with any teaching, suggestion or motivation to incorporate the azo type initiator of Alger in Yamago et al.'s polymerization process.

Furthermore, considering the discussion of unexpected superior results achieved in accordance with the present invention set forth above (also see Table 1 on page 31 of the specification), Applicants take the position that even if a presumption of obviousness has been established, it has been overcome in view of this showing.

For these reasons, Applicants take the position that the presently claimed invention is not suggested by the Yamago et al. and Alger references.

In response to the obviousness-type double patenting rejection of claims 1 and 2 as being unpatentable over claims 1 and 6 of USP 7,291,690, Applicants are submitting a Terminal Disclaimer herewith, as a result of which this rejection should be withdrawn.

The rejection of claims 1 and 2 under 35 U.S.C. §102(e) as being anticipated by the US ‘690 patent is respectfully traversed.

The Examiner takes the position that US ‘690 constitutes prior art under 35 U.S.C. §102(e). This is incorrect. Since WO 2004/014962 (the published version of the International application on which US ‘690 is based) was not published in English, US ‘690 does not have a date under 35 U.S.C. §102(e). Rather, US ‘690 is prior art as of its grant date, i.e. November 6, 2007. For this reason alone, the rejection based on this reference should be withdrawn. However, the WO ‘962 reference is available as prior art against the present invention, as of its publication date, i.e. February 19, 2004. This date is between the PCT filing date for the present application (April 26, 2004) and Applicants’ Japanese priority date (April 25, 2003). Therefore, Applicants can overcome WO ‘962 by obtaining the benefit of the filing date of their Japanese priority application. A verified English translation of the priority application has already been filed, with the response of March 16, 2007. In view of the translation, even the WO ‘962 publication is not available as prior art against the present invention.

Therefore, in view of the foregoing amendment and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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